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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,443	12/03/2003	Ray F. Barnard	END919990119US2	7112

7590 06/06/2005  
Shelley M. Beckstrand  
314 Main Street  
Owego, NY 13827-1616

EXAMINER
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MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



**Office Action Summary**

Application No.

10/727,443

Applicant(s)

BARNARD ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10, 11, 18, 20, 23 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) 18, 23 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 11 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_



### **DETAILED ACTION**

1. Claims 10, 11, and 20 are presented for examination.

#### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
Non-initialed and/or non-dated alterations have been made to the oath or declaration: See 37 CFR 1.52(c).

The address correction of Kerin J. Flannery is not initialed.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10, 11, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, lines 6-7: There is no antecedent basis for "said service providers."

For examination purposes, this phrase will be interpreted as "service providers."

Claim 10, lines 18-19: There is no antecedent basis for "said third party provider teams." For examination purposes, this phrase will be interpreted as "said third party providers."



In lines 4-5 of claim 10, the “potential clients” are recited as “operable by third party providers.” Are the “potential clients” humans or apparatus? If humans, how can they be “operable by third party providers” and how do they relate to the “plurality of customers recited in line 14? If apparatus, how are they different from the recited terminals (e.g., in lines 10 and 12)?

The preamble of claim 10 specifies that the recited system is “for evaluating a potential client system and for adapting a general procurement and accounts payable application to the requirements of each of many potential clients operable by third party providers and for monitoring and assuring the quality of services provided by said service providers.” However, it is not clear what the scope of adapting, monitoring, and assuring is, especially since the body of the claim does not expressly perform these steps. Based on the body of the claim, the mere creation of templates indirectly suffices to assist in adapting, monitoring, and assuring; therefore, these steps are nothing more than intended use. Also, it is unclear how the provision of templates *per se* can “assure” the quality of services provided by the service providers.

Claim 10 recites “serving said templates to members of enterprise teams and said third party provider teams operating said terminals” (lines 17-19). The difference between the enterprise teams and the third party provider teams is not clearly delineated in the claims; therefore, for purposes of examination, the recitation of enterprise teams and the third party provider teams is merely interpreted as various entities (without any clear and defining relationship among these entities).



Claim 10 recites "said third party provider teams operating said terminals" (lines 18-19). It is unclear whether or not the third party provider teams directly operate the recited terminals or whether they indirectly operate the terminals in the sense that they provide the templates that a user may access via the terminals. For examination purposes, either interpretation will be deemed reasonable.

Claim 11, lines 3-4: There is no antecedent basis for "said enterprise team." For examination purposes, this phrase will be interpreted as "said members of enterprise teams."

Claim 11, lines 4-5: There is no antecedent basis for "said enterprise and provider teams." For examination purposes, this phrase will be interpreted as "said members of enterprise teams and said third party providers."

Claim 11 incorporates all of the limitations recited in claim 10 and therefore inherits the same rejections under § 112, 2<sup>nd</sup> paragraph.

Claim 20, lines 6-7: There is no antecedent basis for "said third party service providers." For examination purposes, this phrase will be interpreted as "said third party service provider team members."

Claim 20, lines 15-16: There is no antecedent basis for "said members of said enterprise team." For examination purposes, this phrase will be interpreted as "said enterprise team members."

Claim 20, lines 16-17: There is no antecedent basis for "said third party service providers". For examination purposes, this phrase will be interpreted as "said third party service provider team members."



Claim 20, lines 31-32: There is no antecedent basis for "said service providers."  
For examination purposes, this phrase will be interpreted as "said third party service provider team members."

The preamble of claim 20 specifies that the recited system is "for adapting a general procurement and accounts payable application to the requirements of each of many potential customers operable by third party service provider team members and for enterprise team members to monitor and assure the quality of services provided by said third party service providers to each said potential customer and for providing a repeatable process for training, managing, certifying and educating a service provider to operate a general procurement and accounts payable application on behalf of a customer of an enterprise." However, it is not clear what the scope of adapting and providing a repeatable process for training, managing, certifying, and educating is, especially since the body of the claim does not expressly perform these steps. Based on the body of the claim, the mere creation of templates indirectly suffices to assist in adapting and providing a repeatable process for training, managing, certifying, and educating; therefore, these steps are nothing more than intended use. Also, it is unclear how the provision of templates *per se* can "assure" the quality of services provided by the service providers.

Claim 20 recites "a plurality of team terminals for interfacing to said members of said enterprise team and to members of said third party service providers" (lines 15-17). The difference between the enterprise team and the third party service providers is not clearly delineated in the claims; therefore, for purposes of examination, the recitation of



the enterprise team and third party service providers is merely interpreted as various entities (without any clear and defining relationship among these entities).

Claim 20 recites "team members operating said terminals" (lines 28-29). It is unclear whether or not the team members directly operate the recited terminals or whether they indirectly operate the terminals in the sense that they provide the templates that a user may access via the terminals. For examination purposes, either interpretation will be deemed reasonable.

Claim 20 recites "said team members, responsive to said templates, coordinating, recording and tracking enterprise team activities with respect to said service provider." First, "templates" is a noun; therefore, it is unclear which express action related to the template provokes a response from the team members. Second, it is not clear what is entailed by "coordinating, recording and tracking enterprise team activities" since the team members merely seem to be maintaining templates describing procedures. In other words, the team members do not appear to perform any analysis associated with the templates beyond mere storage of the templates selected by each user; therefore, the intended scope of "coordinating, recording and tracking enterprise team activities" (which typically refers to more in-depth analysis) is vague and indefinite.

Appropriate correction and/or clarification is required.

*The following art rejection reflects Examiner's best understanding of the claimed invention in light of the numerous rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.*



***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gundewar et al. (U.S. Patent No. 6,381,610).

Gundewar discloses a system for using an on-line data gathering tool for evaluating a potential client system and for adapting an application to the requirements of each of many potential clients operable by third party providers and for monitoring and assuring the quality of services provided by said service providers, comprising:

[Claim 10] a server (Fig. 1, #12);

a storage device connected to said server (Fig. 1, #20, 22, 24, 26, 28, 29);

a plurality of terminals (Fig. 1, #14, 16, 18);

a communication link interconnecting said server and said terminals (Fig. 1, #21, 30);

said server (1) maintaining on said storage device, for each of a plurality of customers, a database of templates describing procedures for assessing, preparing developing, deploying and supporting each of said applications, and (2) serving said templates to members of enterprise teams and said third party provider teams operating said terminals (Fig. 1; col. 4, lines 15-51; col. 6, lines 60-64 -- Users in charge of completing or planning project planning tasks can access the necessary templates that



Art Unit: 3623

guide them through company or industry standards "without requiring the user to be familiar with such standards," thereby implying that a third party (i.e., someone external to each user) programs the templates in light of company or industry standards. Also, various entities may interface to one another via the server; see discussion in § 112, 2<sup>nd</sup> paragraph rejection above); and

said server responsive to member input to said templates at said terminals for coordinating, recording and tracking team activity with respect to said application during assessment, preparation, development, deployment and support stages adapting an application to the requirements of a selected one of said potential clients (col. 4, lines 15-51; col. 5, line 42 through col. 8, line 11 -- A project may be tracked from the planning through the completion stages and the related activities may be documented using various templates);

[Claim 11] said terminals being web-enabled terminals and said server further serving to said terminals a panel for task creation by said enterprise team and task use by said enterprise and provider teams (col. 3, lines 16-17; col. 4, lines 15-51; col. 6, lines 60-64 -- Users in charge of completing or planning project planning tasks can access the necessary templates that guide them through company or industry standards "without requiring the user to be familiar with such standards," thereby implying that a third party (i.e., someone external to each user) programs the templates in light of company or industry standards).



While Gundewar discloses that the stored and created templates are used for project management applications, Gundewar fails to expressly teach that the specific type of project management applications include a general procurement and accounts payable application. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art. Furthermore, the Examiner submits that general procurement and accounts payable applications are commonly utilized as part of project management planning. For example, many projects are limited by constraints related to costs, including accounts payable, and the ability to obtain needed resources, i.e., general procurement. In order to more fully understand the limitations imposed on a project as a whole and the likelihood of achieving project goals, a more comprehensive analysis of all factors affecting the project is required. Since Gundewar is already directed toward project management and therefore suggests the incorporation of factors related to project management, the



Art Unit: 3623

Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar to include a general procurement and accounts payable application as part of its project management templates system in order to assist users involved with the planning of a particular project in more fully understanding the limitations imposed on a project as a whole and the likelihood of achieving project goals, thereby yielding a more comprehensive analysis of all factors affecting the project.

Gundewar discloses a system for using an on-line data gathering tool for adapting a general procurement and accounts payable application to the requirements of each of many potential customers operable by third party service provider team members and for enterprise team members to monitor and assure the quality of services provided by said third party service providers to each said potential customer and for providing a repeatable process for training, managing, certifying and educating a service provider to operate an application on behalf of a customer of an enterprise, comprising:

[Claim 20] a first server (Fig. 1, #12);

a storage device connected to said server (Fig. 1, #20, 22, 24, 26, 28, 29);

a plurality of team terminals for interfacing to said members of said enterprise team and to members of said third party service providers (Fig. 1, #14, 16, 18 -- Various entities may interface to one another via the server; see discussion in § 112, 2<sup>nd</sup> paragraph rejection above);



said first server for (1) maintaining a database on said storage device of templates describing procedures for executing said application, and (2) serving said templates to team members operating said terminals; said team members, responsive to said templates, coordinating, recording and tracking enterprise team activities with respect to said service provider (Fig. 1; col. 4, lines 15-51; col. 5, line 42 through col. 8, line 11 -- Users in charge of completing or planning project planning tasks can access the necessary templates that guide them through company or industry standards "without requiring the user to be familiar with such standards," thereby implying that a third party (i.e., someone external to each user) programs the templates in light of company or industry standards).

While Gundewar discloses that the stored and created templates are used for project management applications, Gundewar fails to expressly teach that the specific type of project management applications include a general procurement and accounts payable application. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use



Art Unit: 3623

neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art. Furthermore, the Examiner submits that general procurement and accounts payable applications are commonly utilized as part of project management planning. For example, many projects are limited by constraints related to costs, including accounts payable, and the ability to obtain needed resources, i.e., general procurement. In order to more fully understand the limitations imposed on a project as a whole and the likelihood of achieving project goals, a more comprehensive analysis of all factors affecting the project is required. Since Gundewar is already directed toward project management and therefore suggests the incorporation of factors related to project management, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar to include a general procurement and accounts payable application as part of its project management templates system in order to assist users involved with the planning of a particular project in more fully understanding the limitations imposed on a project as a whole and the likelihood of achieving project goals, thereby yielding a more comprehensive analysis of all factors affecting the project.

While Gundewar teaches that all communications may be conducted through the Internet (col. 3, lines 16-17), Gundewar does not expressly disclose use of a second server interfacing through a firewall to an operational accounting system and a communication link interconnecting said first and second servers and said terminals,



Art Unit: 3623

wherein said second server is for serving operational accounting data to said team terminals. However, the Examiner submits that these limitations are directed toward setting up a firewall between the central server and all clients in communication with the server, which Examiner further submits is old and well-known in the art (including in the art of accounting). Firewalls are used to better control remote access to secure data, thereby protecting the integrity of the data, which is especially important with sensitive information such as accounting data. Since the modified version of Gundewar addresses an accounts payable application (as discussed above) and Gundewar's invention is already disclosed as implemented on the Internet, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to further modify Gundewar to include a second server interfacing through a firewall to an operational accounting system and a communication link interconnecting said first and second servers and said terminals, wherein said second server is for serving operational accounting data to said team terminals in order to better control remote access to secure data, thereby protecting the integrity of the data, which is especially important with sensitive information such as the accounting data already shown as useful in the modified version of Gundewar.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.



Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

May 28, 2005